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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/576,060	08/28/2006	Ralf Dunkel	CS8772BCS033031	2152

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EXAMINER	
FIERRO, ALICIA LORETTA	

ART UNIT	PAPER NUMBER
4121	

MAIL DATE	DELIVERY MODE
12/18/2008	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/576,060	DUNKEL ET AL.	
	Examiner	Art Unit	
	ALICIA L. FIERRO	4121	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *1* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on *9/15/05*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *19-35* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☐ Claim(s) _____ is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☒ Claim(s) *19-35* are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Claims 19-35 are pending in the current application according to the *Amendments to the Claims,* filed September 15, 2006. Furthermore, according to this *Amendment*, claims 1-18 were cancelled and claims 19-35 were added. This application is a 35 U.S.C. § 371 National Stage Filing of International Application No. PCT/EP2004/011408, filed October 12, 2004.

Election/Restrictions

1. Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

Group I Claim(s) 19-26 and 28, drawn to a product of formula I and a composition thereof.

Group II Claim(s) 27 and 30, drawn to a method of making a product of formula I and a composition thereof, wherein the process is that of Claim 27(a).

Group III Claim(s) 27 and 30, drawn to a method of making a product of formula I and a composition thereof, wherein the process is that of Claim 27(b).

Group IV Claim(s) 27 and 30, drawn to a method of making a product of formula I and a composition thereof, wherein the process is that of Claim 27(c).

Group V Claim(s) 27 and 30, drawn to a method of making a product of formula I and a composition thereof, wherein the process is that of Claim 27(d).

Group VI Claim(s) 27 and 30, drawn to a method of making a product of formula I and a composition thereof, wherein the process is that of Claim 27(e).

Group VII Claim(s) 29, drawn to a method of using the product of formula I.

Group VIII Claim(s) 31, drawn to an aniline compound of formula III(b).

Group IX Claim(s) 32, drawn to an isopentene compound of formula V.

Group X Claim(s) 33, drawn to an isopentene compound of formula VI.

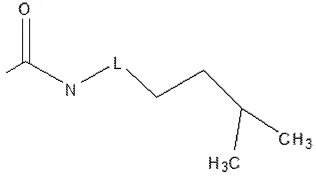
Group XI Claim(s) 34, drawn to an isopentyne compound of formula VII.

Group XII Claim(s) 35, drawn to an alkanoneaniline compound of formula X.

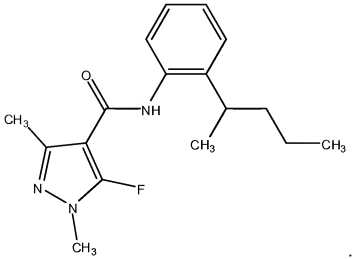
2. As set forth in Rule 13.1 of the Patent Cooperation Treaty (PCT), "the international application shall relate to one invention only or to a group of inventions." Moreover, as stated in Rule 13.2 PCT, Unity of Invention is satisfied "where a group of inventions is claimed in one and the same international application, the requirement of unity referred to in Rule 13.1 shall be fulfilled only where there is a technical relationship among those inventions involving one or more of the same or corresponding special technical features."

The expression "special technical features" shall mean those technical features that define a contribution which each of the claimed inventions, considered as a whole makes over the prior art so linked as to form a single general inventive concept. The inventions listed as Groups I-XII do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or

corresponding special technical features for the following reasons: There is no technical feature common to all of the claims. The technical feature common only to the claims in Groups I-VI is the compound of formula I, as defined in claim 19. However, this technical feature is not shared by any of the inventions set forth in Groups VII-XII, nor is there a consistent shared technical feature between the compounds of said groups. Additionally, prior art exists which causes the core structure in the instant application to lack a special technical feature. The core structure here is:



. Note that the only variable portion of the compound included in what is considered the core structure is the L group because it links the two sides of the core molecule. Obvious variants of this structure can be found in numerous patents and papers. For example, WO 03/010149 (cited by applicant in the instant application) teaches the compound 5-fluoro-1,3-dimethyl-N-(2-(pentan-2-yl)phenyl)-1H-pyrazole-4-carboxamide (Compound I-17 on page 54 in the application), along with several others that also make use of this core structure. The structure of the compound in the application is as follows:



. Although compound I-17 has a methyl substitution on the branched alkyl chain that is not present in the instant application, In re Wood established that hydrogen and methyl are deemed obvious variants of each other. Therefore, the feature linking the claims does not constitute a special technical feature as defined by PCT Rule 13.2, as it does not define a contribution over the prior art.

Accordingly, Groups I-XII are not so linked by the same or a corresponding special technical feature as to form a single general inventive concept. Therefore, unity of invention is considered to be lacking and restriction of the invention in accordance with the rules of unity of invention is considered to be proper.

Election of Species

Applicant is further required to elect a single disclosed species within the elected group and to provide the structure of this elected species. Upon election of any one of Groups I-XII, applicant must further elect a **single** disclosed species with the formula I, IIIb, V, VI, VII, or X, with the formula being dependent upon the general structures of the

compounds in the elected group. In order for this election to be considered fully responsive to this requirement the election **must include**:

Groups I-VII:

a. The **name** and **structure** of a specific compound of formula (I)

b. The **location** of that species (a) within the claims of (b) within the specification,

c. The **claims** that read on the elected species,

d. and a **definition** of the exact substitutions

e.g. R_1 is hydrogen, X is oxygen, etc.

Group II

a. The **name** and **structure** of a specific carboxylic acid of formula (II) to be used in the reaction

b. The **name** and **structure** of a specific aniline derivative of formula (III) to be used in the reaction

c. The **location** of each species (a) within the claims of (b) within the specification

d. The **claims** that read on the elected species

e. and a **definition** of the exact substitutions

e.g. R_1 is hydrogen, X is oxygen, etc

Group III:

a. The **name** and **structure** of a specific isopentylcarboxanalide of formula (I-a)

b. The **name** and **structure** of a specific halide of formula (IV)

c. The **location** of each species (a) within the claims of (b) within the specification,

d. The **claims** that read on the elected species,

e. and a **definition** of the exact substitutions

e.g. R_1 is hydrogen, X is oxygen, etc.

Group IV:

a. The **name** and **structure** of a specific isopentone of formula (V)

b. The **location** of that species (a) within the claims of (b) within the specification,

c. The **claims** that read on the elected species,

d. and a **definition** of the exact substitutions

e.g. R_1 is hydrogen, X is oxygen, etc.

Group V:

a. The **name** and **structure** of a specific isopentene of formula (VI)

b. The **location** of that species (a) within the claims of (b) within the specification,

c. The **claims** that read on the elected species,

d. and a **definition** of the exact substitutions

e.g. R_1 is hydrogen, X is oxygen, etc.

Group VI:

a. The **name** and **structure** of a specific isopentyne of formula (VII)

b. The **location** of that species (a) within the claims of (b) within the specification,

c. The **claims** that read on the elected species,

d. and a **definition** of the exact substitutions

e.g. R_1 is hydrogen, X is oxygen, etc.

Group VIII:

a. The **name** and **structure** of a specific aniline derivative of formula (III-b)

b. The **location** of that species (a) within the claims of (b) within the specification,

c. The **claims** that read on the elected species,

d. and a **definition** of the exact substitutions

e.g. R_1 is hydrogen, X is oxygen, etc.

Group IX:

a. The **name** and **structure** of a specific isopentone derivative of formula (V)

b. The **location** of that species (a) within the claims of (b) within the specification,

c. The **claims** that read on the elected species,

d. and a **definition** of the exact substitutions

e.g. R_1 is hydrogen, X is oxygen, etc.

Group X:

a. The **name** and **structure** of a specific isopentene derivative of formula (VI)

b. The **location** of that species (a) within the claims of (b) within the specification,

c. The **claims** that read on the elected species,

d. and a **definition** of the exact substitutions

e.g. R_1 is hydrogen, X is oxygen, etc.

Group XI:

a. The **name** and **structure** of a specific isopentyne derivative of formula (VII)

b. The **location** of that species (a) within the claims of (b) within the specification,

c. The **claims** that read on the elected species,

d. and a **definition** of the exact substitutions

e.g. R_1 is hydrogen, X is oxygen, etc.

Group XII:

a. The **name** and **structure** of a specific alkanoneaniline compound of formula (VII)

b. The **location** of that species (a) within the claims of (b) within the specification,

c. The **claims** that read on the elected species,

d. and a **definition** of the exact substitutions

e.g. R_1 is hydrogen, X is oxygen, etc.

Applicant is required, in reply to this action, to elect a single species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. The reply must also identify the claims readable on the elected species, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered non-responsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

2. The species listed above do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, the species lack the same or corresponding special technical features for the following reasons: The core structure common to all compounds in groups I-VII fails to overcome that of the prior art, namely WO 03/010149 which was provided by Applicant. Additionally, for example, a compound of formula (I) wherein A has a core pyrazole ring (formula A1) is structurally different than a compound of formula (I) wherein A has a core thiophene ring (formula A2).

3. Applicant is advised that the reply to this requirement to be complete must include (i) an election of a species or invention to be examined even though the

requirement may be traversed (37 CFR 1.143) and (ii) identification of the claims encompassing the elected invention.

The election of an invention or species may be made with or without traverse. To preserve a right to petition, the election must be made with traverse. If the reply does not distinctly and specifically point out supposed errors in the restriction requirement, the election shall be treated as an election without traverse.

4. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

5. The examiner has required restriction between product and process claims. Where applicant elects claims directed to the product, and the product claims are subsequently found allowable, withdrawn process claims that depend from or otherwise require all the limitations of the allowable product claim will be considered for rejoinder. All claims directed to a nonelected process invention must require all the limitations of an allowable product claim for that process invention to be rejoined.

In the event of rejoinder, the requirement for restriction between the product claims and the rejoined process claims will be withdrawn, and the rejoined process claims will be fully examined for patentability in accordance with 37 CFR 1.104. Thus, to be allowable, the rejoined claims must meet all criteria for patentability including the requirements of 35 U.S.C. 101, 102, 103 and 112. Until all claims to the elected product

are found allowable, an otherwise proper restriction requirement between product claims and process claims may be maintained. Withdrawn process claims that are not commensurate in scope with an allowable product claim will not be rejoined. See MPEP § 821.04(b). Additionally, in order to retain the right to rejoinder in accordance with the above policy, applicant is advised that the process claims should be amended during prosecution to require the limitations of the product claims. **Failure to do so may result in a loss of the right to rejoinder**. Further, note that the prohibition against double patenting rejections of 35 U.S.C. 121 does not apply where the restriction requirement is withdrawn by the examiner before the patent issues. See MPEP § 804.01.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to ALICIA L. FIERRO whose telephone number is (571)270-7683. The examiner can normally be reached on Monday - Friday 8:00-5:00, with alternating Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Patrick Nolan can be reached on (571)272-0847. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

A.L.F.

/Patrick J. Nolan/
Supervisory Patent Examiner, Art Unit 4121